

REMARKS

Reconsideration and allowance are respectfully requested.

Claims 13-14, 24 and 31-34 are pending. Claims withdrawn from consideration by the Examiner are canceled without prejudice or disclaimer to their later prosecution. The amendments are fully supported by the original disclosure and, thus, no new matter is added by their entry.

A verified English translation of the priority document is submitted herewith. The Examiner is requested to acknowledge perfection of the claim for priority benefit.

35 U.S.C. 112 – Definiteness

Claims 14 and 30 were rejected as being allegedly “indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” Applicants traverse because the phrase “significant transferring activity” is clarified by replacement with the description that the protein --transfers GlcNAc from UDP-GlcNAc to an acceptor substrate having an oligosaccharide residue in a quadruple-stranded form at the nonreducing end of an N-linked oligosaccharide through a β 1,3 glycosidic linkage and synthesizes an oligosaccharide--. One of skill in the art would understand that the protein would have this significant transferring activity. Similarly, the skilled artisan would understand that the pH optimum is around pH 7 (i.e., neutral pH).

Applicants request withdrawal of the Section 112, second paragraph, rejection because the pending claims are clear and definite.

35 U.S.C. 112 – Written Description

Claims 14 and 30 were rejected because they allegedly contain “subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” Applicants traverse because the present claim amendments moot this rejection.

Withdrawal of the written description rejection is requested because the specification conveys to a person skilled in the art that Applicants were in possession of the claimed invention as of the filing date.

35 U.S.C. 112 – Enablement

Claims 14 and 30 were rejected because it was alleged that the specification “does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with the claims.” Applicants traverse because the present claim amendments moot this rejection. The Examiner admits on page 7 of the Action that proteins comprising the amino acid sequence of SEQ ID NO: 2 or SEQ ID NO: 16 are enabled. Further, Example 5 of the Applicants’ specification demonstrates that the claimed protein has the biochemical activity recited in the claims.

Withdrawal of the enablement rejection is requested because it would not require undue experimentation for a person of skill in the art to make and use the invention as claimed by Applicants.

35 U.S.C. 103 and 103 – Novelty and Nonobviousness

A claim is anticipated only if each and every limitation as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is claimed. See *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

To establish a case of prima facie obviousness, all of the claim limitations must be taught or suggested by the prior art. See M.P.E.P. § 2143.03. A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. *In re Kahn*, 78 USPQ2d 1329, 1334 (Fed. Cir. 2006) citing the legal standard provided in *Graham v. John Deere*, 148 USPQ 459 (1966). The *Graham* analysis needs to be made explicitly. *KSR v. Teleflex*, 82 USPQ2d

1385, 1396 (2007). It requires findings of fact and a rational basis for combining the prior art disclosures to produce the claimed invention. See *id.*

Claims 14 and 30 were rejected as allegedly anticipated by Withers et al. (U.S. Patent No. 6,204,029), Conklin et al. (U.S. Patent No. 6,416,988), or Daffo et al. (WO 02/079449) and allegedly obvious over Gendreau et al. (WO 2004/066948). Applicants traverse because the cited documents do not teach or suggest a protein comprising the amino acid sequence of SEQ ID NO: 2 or 16.

Withdrawal of the Section 102 and 103 rejections is requested because the cited documents fail to disclose all limitations of the claimed invention.

Conclusion

Having fully responded to the Office Action, Applicants submit that the claims are in condition for allowance and earnestly solicit an early Notice to that effect. The Examiner is invited to contact the undersigned if any further information is required.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 

Gary R. Tanigawa
Reg. No. 43,180

901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100